

Hearing:
Sept. 22, 1999

Paper No. 24
RFC

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB APRIL 4, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re National Society of Chartered Bank
Auditors

Serial No. 74/589,971

Robert G. Shepherd of Matthews, Collins, Shepherd & Gould
for National Society of Chartered Bank Auditors.

John Dalier, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Cissel, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

This is an appeal from the final refusal to register
"CERTIFIED FINANCIAL SERVICES AUDITOR" on the Supplemental
Register for "educational services namely, providing courses
of continuing instruction and educational testing for
auditors and distributing course materials in connection
therewith," in Class 41. The application as originally filed
had sought registration on the Principal Register as a

certification mark for "auditory services," in Class B, but subsequent amendment responsive to the Examining Attorney's refusal to register under Section 2(e)(1) of the Act resulted in the present status of the application for registration as a service mark on the Supplemental Register. The original application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce as a certification mark, but an amendment to allege use was submitted in support of the amendment to seek registration on the Supplemental Register as a service mark.

The Examining Attorney refused registration as a service mark on the Supplemental Register under Section 23 of the Lanham Act on the ground that applicant's mark is generic as applied to the services specified in the amended application, and as such, is incapable of identifying applicant's services and distinguishing them from similar services rendered by others. In support of this refusal, he submitted a dictionary definition of the word "certified" as "guaranteed of meeting a standard." Excerpts from twenty-three published articles retrieved from the Nexis database were submitted wherein the term "financial services auditor" is used in connection with professionals who examine financial records. Additional excerpts were made of record wherein the term "certified" is used as an indication that a person has

achieved and maintained a particular level of expertise or knowledge in a particular field or profession, and that level of expertise or knowledge has been independently verified. The Examining Attorney also made of record copies of eight registrations wherein each registrant had disclaimed phrases which included the word "certified" in connection with educational services.

Further, the Examining Attorney submitted excerpts from two additional stories retrieved from the Nexis database. In the first, an individual is identified as "recently certified as a financial services auditor." The second article refers to another individual as "a certified financial services auditor." The Examining Attorney acknowledged, however, that both articles referred to the fact that the referenced certification had been granted by applicant.

From this information the Examining Attorney determined that applicant "...is actually more widely using the mark as a certification mark, [rather than as a service mark], namely as indicating that persons so certified have met certain standards of expertise in this specific area of auditing..." Notwithstanding this comment, the Examining Attorney, citing *In re Mortgage Bankers Association of America*, 226 USPQ (TTAB 1985), as directly on point, concluded that the mark applicant seeks to register is the generic name for

applicant's services, and thus is incapable of identifying and distinguishing the source of applicant's services. He then made final the refusal to register under Section 23.

Responsive to the third Office Action, applicant presented arguments in support of registrability on the Supplemental Register. Applicant submitted copies of eight third-party registrations wherein marks which applicant argues are no less descriptive than the mark which applicant seeks to register have been registered, either with disclaimers or on the Supplemental Register.

When the refusal to register on the Supplemental Register was made final, applicant appealed, but also filed a request for suspension of action on the appeal and for reconsideration of the application by the Examining Attorney. Copies of two third-party registrations were attached to the request for reconsideration.

The request for reconsideration was denied by the Examining Attorney, the Board resumed action on the appeal, and both applicant and the Examining Attorney submitted briefs. Following applicant's submission of a reply brief,¹

¹ In this regard, we note that the evidence submitted with applicant's reply brief is manifestly untimely, and therefore has not been considered. Trademark Rule 2.142(d).

an oral hearing was conducted at which both applicant and the Examining Attorney presented their arguments to the Board.

The sole issue on appeal is whether the term sought to be registered on the Supplemental Register is capable of identifying and distinguishing applicant's services. Based on careful consideration of the record in this case and the arguments made by applicant and the Examining Attorney, we find that it is.

The test for registrability on the Supplemental Register is well settled. As originally stated by our primary reviewing court in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986), and recently restated in *In re American Fertility Society*, 188 F.3rd 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), two inquiries must be made. First, we must determine what the genus or class of the services in question is. Second, we must ask whether the term sought to be registered is understood by the relevant public primarily to refer to that genus or class of services. The critical issue is whether members of the relevant purchasing public primarily use or understand the entire term sought to be protected to refer to the genus of the services in question. The Court made it clear that the burden of proof in this regard is on the Patent and Trademark Office to show that the term is

generic if it has been refused registration even on the Supplemental Register.

In the American Fertility Society case, the Court found that the Office had failed to meet its burden of showing that the phrase "SOCIETY FOR REPRODUCTIVE MEDICINE," in its entirety, was a generic designation. The Examining Attorney had provided, as support for his refusal to register, dictionary definitions of the component words in the phrase; third-party applications and registrations for marks containing (and disclaiming) the term "society"; and articles retrieved from the Nexis database reflecting common uses of the term "reproductive medicine." In finding that this evidence fell short of meeting the Examining Attorney's burden, the Court emphasized that the fact that there was not even one example of the use of the entire term by others was strong evidence that the term was not a generic term (i.e., an apt or common name) for the applicant's services.

The record before the Board in the instant appeal clearly demonstrates that the Patent and Trademark Office has been inconsistent in its treatment of marks like the one here sought to be registered. The third-party registrations referred to by both applicant and the Examining Attorney and the Board's decision in *In re Mortgage Bankers Association of*

America, supra, reveal disparate outcomes when this issue has been addressed.

Using the Ginn and American Fertility Society guidelines as our basis for analysis of this issue in the case at hand, however, we must look to the evidence of record in order to determine the primary significance of the term to the relevant purchasing public. In this regard, we are presented with a dictionary definition of the term "certified"; excerpts from the Nexis® database in which "certified" is used in conjunction with the words "education" and "testing"; and evidence that individuals who have been certified by applicant are referred to as "certified financial services auditors." The Examining Attorney concludes that these articles show that the designation "CERTIFIED FINANCIAL SERVICES AUDITOR" identifies a financial services auditor who has achieved a certain level of professional accomplishment in the field, as determined by applicant.

While this may be so, it does not logically lead to the Examining Attorney's conclusion (in his brief on p.7) that the relevant public understands the designation to refer to a class of services, much less that it refers to educational services of the type specified in the application. To the contrary, we agree with applicant that the genus of the services rendered by applicant under the mark is educational

services, more specifically, providing courses, materials and testing for auditors. The evidence that auditors certified by applicant refer to themselves, or are referred to by others, as "certified financial services auditors" does not establish that the relevant purchasing public for the educational services specified in the application understands the term sought to be registered as the generic name for those educational services.

To the contrary, it is telling that the Examining Attorney was unable to find evidence of the use of the complete term sought to be registered in connection with anything other than members of the applicant organization who have availed themselves of applicant's educational services. Just as in the Ginn and American Fertility Society cases, if the phrase were understood by members of the relevant public to refer to the genus of services in question, it would seem that it would have been used at some time by someone other than applicant (whose use as a service mark has not been questioned by the Examining Attorney) as the name of those services.

The Examining Attorney has not met his burden of establishing that the term sought to be registered is understood by the purchasing public as the name of the class or genus of the services specified in the application.

Ser No. 74/589971

Accordingly, the refusal to register under Section 23 the Act on the ground that the term is incapable of identifying applicant's services and distinguishing them from similar services rendered by others is reversed.

R. F. Cissel

D. E. Bucher

G. F. Rogers
Administrative Trademark Judges,
Trademark Trial & Appeal Board

Ser No. 74/589971